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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,680	06/27/2003	Michael J. Bertoja	68.0338	8256
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EXAMINER
FRISTOE JR, JOHN K

ART UNIT	PAPER NUMBER
3754	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,680

Applicant(s)

BERTOJA, MICHAEL J.

Examiner

John K. Fristoe Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 19 is/are allowed.
- 6) ☒ Claim(s) 10-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 10-18 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 1, respectively, of U.S. Patent No. 6,325,150 in view of U.S. Pat. No. 6,056,292 (Gerigk). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-9 and 1 of U.S. Pat. No. 6,325,150 in view of U.S. Pat. No. 6,056,292 (Gerigk) "anticipates" Application claims 10-18, and 20, respectively. Accordingly, Application claims 10-18 and 20 are not patentably

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distinct from claims 1-9 and 1, respectively, of U.S. Pat. No. 6,325,150 in view of U.S. Pat. No. 6,056,292 (Gerigk).

Here Patent claim 1 requires:

A flow control device for controlling the flow rate through tubing placed in an oil well, the tubing including at least one hole therethrough, the device comprising:

- A closure sleeve adapted to slide over the tubing hole;
- A first seal and a second seal respectively mounted on the tubing on either side of the tubing hole, the first and second seals cooperating in a fluid-tight manner with the closure sleeve;
- A protective sleeve mounted in alignment with the closure sleeve and proximate to the first seal; and
- A return mechanism for automatically returning the protective sleeve to a covering position in which the protective sleeve covers the seal when the first seal is not covered by the closure sleeve.

While Application claim 10 requires:

A flow control device for controlling the flow rate through tubing placed in a well, the tubing including at least one hole therethrough, the device comprising:

- A closure sleeve adapted to slide over the tubing hole;
- One or more seals mounted downstream of the tubing hole, the one or more seals comprising in a fluid-tight manner with the closure sleeve, the one or more seals having a wave-like geometry;

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- A protective sleeve mounted in alignment with the closure sleeve and proximate to the one or more seals; and
- A return mechanism for automatically retaining the protective sleeve to a covering position in which the protective sleeve covers the one or more seals when the one or more seals are not covered by the closure sleeve.

Following the rationale in *In re Goodman* cited in the preceding paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 10 is anticipated by claim 1 of U.S. Pat. No. 6,325,150, and since anticipation is the epitome of obviousness, then Application claim 10 are obvious over claim 1 of U.S. Pat. No. 6,325,150.

In addition Application claim 10 requires the one or more seals having a wave-like geometry, claim 1 of U.S. Pat. No. 6,325,150 only requires a seal. Gerigk teaches a seal (9) on a shaft having a wave-like geometry (figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Application claim 10 by having a seal with wave-like geometry as taught by Gerigk in order for there to be more sealing surface area on the shaft to increase the effective sealing area.

Likewise, claim 1 of Patent “anticipates” Application claim 20. Accordingly claim 20 is not patentably distinct from Patent claim 1.

Here Patent claim 1 requires:

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A flow control device for controlling the flow rate through tubing placed in an oil well, the tubing including at least one hole therethrough, the device comprising:

- A closure sleeve adapted to slide over the tubing hole;
- A first seal and a second seal respectively mounted on the tubing on either side of the tubing hole, the first and second seals cooperating in a fluid-tight manner with the closure sleeve;
- A protective sleeve mounted in alignment with the closure sleeve and proximate to the first seal; and
- A return mechanism for automatically returning the protective sleeve to a covering position in which the protective sleeve covers the seal when the first seal is not covered by the closure sleeve.

While Application claim 20 requires:

A well completion, comprising:

- A tubing including at least one hole therethrough;
- A closure sleeve adapted to slide over the tubing hole;
- One or more seals mounted on the tubing hole, the one or more seals cooperating in a fluid-tight manner with the closure sleeve, the one or more seals having a wave-like geometry;
- A protective sleeve mounted in an alignment with the closure sleeve and proximate to one or more seals; and

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- A return mechanism for automatically retaining the protective sleeve to a covering position in which the protective sleeve covers the one or more seals when the one or more seals are not covered by the closure sleeve.

Following the rationale in *In re Goodman* cited in the preceding paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 20 is anticipated by claim 1 of U.S. Pat. No. 6,325,150, and since anticipation is the epitome of obviousness, then Application claim 20 are obvious over claim 1 of U.S. Pat. No. 6,325,150.

In addition Application claim 10 requires the one or more seals having a wave-like geometry, claim 1 of U.S. Pat. No. 6,325,150 only requires a seal. Gerigk teaches a seal (9) on a shaft having a wave-like geometry (figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Application claim 20 by having a seal with wave-like geometry as taught by Gerigk in order for there to be more sealing surface area on the shaft to increase the effective sealing area.

3. Similarly, claims 11-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9, respectively, for the same reason set forth above.

Allowable Subject Matter

4. Claims 1-9 and 19 are allowed.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

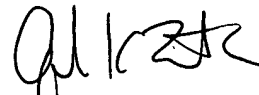
U.S. Pat. No. 3,183,009 (Kunel) discloses a wave-like seal.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Fristoe Jr. whose telephone number is (703) 308-1437. The examiner can normally be reached on Monday-Friday, 7: 00 a.m-4: 30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Louis G. Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JKF


John K. Fristoe Jr.
Examiner
Art Unit 3754


EDWARD K. LOOK
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9/29/04